

REMARKS

Summary of the Office Action

Claims 1-6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Hardy* (USPN 5,541,000).

Summary of the Response to the Office Action

Claim 1 has been amended.

Claims 2 and 5 have been cancelled.

Claims 7-18 have been added.

Accordingly claims 1, 3, 4 and 6-18 are pending in the application and are respectfully submitted for consideration by the Examiner.

The Rejection Under 35 U.S.C. § 102(b)

Claims 1-6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Hardy* (USPN 5,541,000). Applicants respectfully traverse the rejection for at least the following reasons.

Claim 1, as proposed to be amended, recites an embedding resin assuming a color having a base color tone selected from among black, blue, green, red, orange, yellow, and violet, and comprising a thermosetting resin and at least one inorganic filler, wherein the at least one inorganic filler has a particle size range of about 0.1 μm to 50 μm . Support for this amendment can be found in the specification at, *e.g.*, page 14, paragraph [0059].

In contrast to the claimed invention, *Hardy* fails to disclose an embedding resin wherein the embedding resin comprises a thermosetting resin and at least one inorganic filler, wherein at least one inorganic filler has a particle size range of about 0.1 μm to 50 μm . Hence, the relied upon prior art fails to disclose each and every feature of claim 1.

For at least the above reasons, Applicants respectfully submit that claim 1, as proposed to be amended, fully complies with the requirements of 35 U.S.C. § 102(b). Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 102(b) be withdrawn.

Dependent Claims 2-6

Dependent claims 2 and 5 have been cancelled. Accordingly, the rejections of these claims are now moot. Moreover, Applicants respectfully submit that dependent claims 3, 4 and 6 are allowable at least because of their dependence from independent claim 1, as proposed to be amended, and the reasons set forth above.

Newly Added Claims

Claims 7-11

Applicants have added dependent claims 7-11. Applicants respectfully submit that claims 7-11 are allowable at least because of their dependence from independent claim 1, and the reasons set forth above.

Claim 12

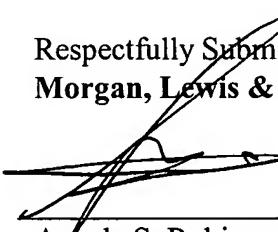
Independent claim 12 is directed toward an embedding resin for embedding an electronic part in an insulating substrate comprising carbon black in an amount of 0.1-1.4 mass %. Applicants respectfully submit that support for claim 12 can be found, for example, in the specification, *e.g.*, at page 11, paragraph [0049] through page 12, paragraph [0051]. No new matter has been added by this new claim. Furthermore, Applicants respectfully submit that claims 13-18 are allowable at least because of their dependence from independent claim 12 and the additional features recited therein. Accordingly, Applicants respectfully submit that new claims 12-18 are allowable over the applied art.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claim. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.R.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully Submitted,
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